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#### REMARKS

This Amendment is submitted in response to the Office Action mailed on June 19, 2007. Claims 1 - 6, 8, 10, and 21 - 26 are pending, and all stand rejected at present.

Dependent claim 27 is added. No fee is due. Support is found in the Specification, page 4, lines 14 - 23, and at other locations.

Support for amendments to claim 25 is found in (1) previous claim 26 and (2) the Specification, page 7, line 11, et seq.

#### RESPONSE TO ANTICIPATION REJECTIONS

Claims 1 - 3, 8, and 10 were rejected on grounds of anticipation, based on Dickson.

#### Claim 1

Claim 1 recites, in part:

locating the vehicle adjacent a  
transaction terminal;

transferring one or more computer  
programs from the transaction terminal to an  
in-car data entry facility maintained within  
the vehicle, **which programs generate a user  
interface in the entry facility.**

To repeat, the claim states that

-- "programs" are transferred to the "data

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entry facility" "within the vehicle," and  
-- the "programs generate a user interface  
in the entry facility."

No such "programs," which are so transferred, are found in  
Dickson.

#### Dickson Reference

Dickson shows a drive-in convenience store, wherein vehicles  
enter and the driver-customers can make purchases. (Column 6,  
lines 5 - 10.)

#### PTO's Application of Dickson

The Office Action cites Dickson passages at, column 18,  
lines 15 - 17 and lines 28 - 40, as showing the claimed transfer  
of programs.

These passages, and nearby passages, refer to an IVC, in-  
vehicle controller (column 2, line 2). These passages state that

-- "menu information" is transferred to the  
IVC, and  
-- the IVC may retain the "menu information"  
for future transactions at the convenience  
store (thereby eliminating the requirement of  
another transfer).

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POINT 1

Dickson states that "menu information," that is, **data**, is transferred to the IVC.

The claim recites "programs" which "generate a user interface."

The **data** of Dickson does not correspond to the claimed "programs."

By analogy, the PTO is confusing a word-processing **program** with a word processing **document**, which the program would generate, display, and print. The **program** has completely different properties than does the **document**.

A **program** runs on a microprocessor. Its content, the instructions, must conform to the rules of syntax and programming established by the designer of the microprocessor.

Such stringent requirements do not apply to data, such as a word processor document. In fact, such a document can be pure gibberish, which makes no sense at all.

POINT 2

As stated above, Dickson's IVC may retain the menu **data**. Dickson states that, when the customer returns at a later time, that retained **data** is updated by **new data**, if necessary, for example, when prices change. (Column 18, lines 33 - 36.)

Clearly, this updating shows that Dickson transfers **data**,

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not a "program" as claimed. The updating transfers new information, that is, data.

#### POINT 3

If Dickson were to transfer a "program," Dickson would need to know the type of microprocessor running in the IVC being used by the customer. The reason is that different microprocessors utilize different instruction sets, so that a program written for one microprocessor will not run on another microprocessor.

As a specific example, Apple computers using microprocessors manufactured by Motorola (or equivalent) cannot run programs written for IBM PCs, which use microprocessors manufactured by Intel (or equivalent).

The undersigned attorney can find no discussion in Dickson wherein he states that he identifies the type of IVC used by the customer.

Therefore, it is reasonable to conclude that Dickson does not transfer a "program" as claimed. He transfers **data**.

#### POINT 4

Dickson states, and implies, that literally hundreds of different types of IVCs can be used. (Column 7, lines 43 - 55.) Thus, hundreds of different types of microprocessors can be expected.

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In order for Dickson to be operative to transfer "programs," as claimed, he must, as a minimum,

- identify each type of microprocessor,
- maintain a program for each type of microprocessor,
- select the appropriate program, based on the identification, and
- transfer the selected program.

The undersigned attorney can find a discussion of none of this in Dickson.

Thus, Dickson is non-enabling for the process of transferring a program to the IVC, which program generates a user interface.

For a reference to be anticipatory under section 102, the reference must be enabling. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1), copies attached.)

Since Dickson is non-enabling on the process of transferring programs to the IVCs, Dickson cannot anticipate.

#### POINT 5

As stated above, Dickson states that he updates the retained menu-data, as when prices change.

If that retained data were a "program," as claimed, then there is no enablement in Dickson for (1) later transferring an

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update for the program and (2) incorporating the update into the retained program.

In general, such a process (of modifying a computer program) is very complex, and it is doubtful that Dickson performs it. In any case, he does not discuss it.

Further, he would have to maintain a collection of update-programs, one for each of the hundreds of microprocessors discussed above. He does not discuss that, and does not show enablement for that.

Therefore, if Dickson's updates (column 18, line 35) are interpreted as updates to computer programs, Dickson is non-enabling for such an interpretation.

If he is non-enabling, he cannot anticipate.

#### **Other Claims**

The discussion above applies to the other claims in this group.

#### **RESPONSE TO OBVIOUSNESS REJECTIONS - PART 1**

Claims 21 - 26 were rejected as obvious, based on Dickson and DeVries.

#### **Claim 21**

##### Point 1

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No valid teaching has been given for combining the references. One rationale given, in essence, asserts that certain properties of the combination of references are desirable, and thus the references should be combined for that reason.

However, that is not a teaching for combining the references in the first place. That merely points to supposed properties of the references, once combined.

If this type of rationale suffices as a teaching under section 103, then almost all, and possibly all, inventions ever made would be obvious. The reason is that all inventions have some properties or other which are considered desirable.

Therefore, the mere presence of desirable properties in the combination of references is not a basis for rejection under section 103.

#### Point 2

The MPEP requires that the teaching be found in the prior art. MPEP § 706.02(j) states:

#### Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

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First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . .

The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

But the rationale points to properties of the combined references as a justification for combining the references.

The PTO has not shown that justification in the prior art.

#### Conclusion

Applicant thus submits that no valid teaching has been given for combining the references.

#### **Claims 22 and 26**

Claim 26 has been cancelled.

The Office Action asserts that Dickson shows the claimed transfer of computer programs.

#### Point 1

Applicant believes that the discussion above indicates that the claimed transfer of computer programs is not shown in



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Dickson. Thus, even if the references are combined, the claimed transfer of programs is not found. MPEP § 2143.03 states:

To establish prima facie obviousness . . .  
**all the claim limitations** must be taught or  
suggested by the prior art.

#### Point 2

DeVries discusses an interface in the device which is mounted in his vehicle. It is clear that (1) no programs are transferred to that interface, and (2) the interface requires no transfer of programs. (See column 5, lint 57 et seq.; column 9, liner 15 et seq.)

Thus, DeVries teaches away from the concept of transferring programs to the device within the vehicle, and thus contradicts the supposed teaching of program-transfer found in Dickson.

#### **Claim 25**

Claim 25 has been amended to be of the "consisting essentially of" type (as opposed to "comprising" type). Thus, the agglomeration of elements from the two references does not show this claim.

To show claim 25, the claimed elements must be shown in the combined references, with the absence of anything else which is not "consisting essentially of" the claimed elements.

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#### **Other Claims**

The discussion above applies to the remaining claims in this group.

#### **RESPONSE TO OBVIOUSNESS REJECTIONS - PART 2**

Claims 4 - 6 are considered patentable, based on their parent claims.

#### **ADDED CLAIM**

##### **Claim 27**

Claim 27 refers, for example, to a situation wherein, under parent claim 1, a first program is transferred at one location, such as at an ATM, and, under dependent claim 27, a second program is transferred at a second location.

That is not seen in the references, even if combined.

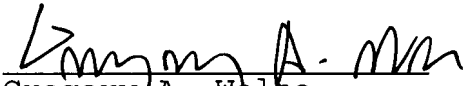
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#### CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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ATTACHED: Chisum on Patents, Sections 3.04(1) and 3.06(1)(a)

# PATENTS

**A Treatise on the Law of Patentability, Validity and  
Infringement**

*by*

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**Matthew Bender**



**Times Mirror  
Books**

### § 3.04 Description in a Publication

Since 1836, the United States patent statutes have barred a patent if the invention was “described in a printed publication in this or a foreign country” prior to the applicant’s date of invention.<sup>1</sup> Thus, a publication, wherever found, may anticipate a later invention.<sup>2</sup> All publications are part of the store of common knowledge to which persons with practical problems should look before engaging in original inventive activity.

Anticipation by a prior publication occurs where the work adequately describes the invention in question and the work qualifies as a “printed publication.”

#### [1]—Adequate Description

To constitute an anticipation, a printed publication must describe the invention. The description must be adequate to a person with ordinary skill in the art to which the invention pertains. By the weight of authority, the description must enable such a person not only to comprehend the invention but also to make it. The listing of a chemical compound by name or formula as a speculative or theoretical possibility will not constitute an anticipation though it is evidence of obviousness.

[a]—Supreme Court Cases. In two decisions, the Supreme Court appeared to state different tests as to the adequacy of the description in a publication to constitute anticipation. In *Seymour*, it stated that the description must be sufficiently full to

#### § 3.04

<sup>1</sup> The earliest patent statutes referred to the invention not being “before known or used” or “described in some public work.” Act of Feb. 21, 1793, ch. 11, §§ 1, 6, 1 Stat. 318; Act of Apr. 10, 1790, Ch. 7, § 1, 1 Stat. 109. The 1836 Act directed the Commissioner of Patents to reject applications for patents on inventions that had been “described in any printed publication in this or any foreign country.” Act of July 4, 1836, ch. 357, § 7, 5 Stat. 117.

<sup>2</sup> 35 U.S.C. § 102(a): “A person shall be entitled to a patent unless—(a) the invention was . . . described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.”

Compare Linn, “TSCA and Patentability,” 62 J. Pat. Off. Soc’y 131 (1980) (urging that the patent statutes be amended to exclude as prior art involuntary publications disclosing a chemical compound by the inventor or the inventor’s assignee under the Toxic Substances Control Act).

[a]—**Enablement Standard.** Most decisions assume that the standard for anticipation by patenting is the same one of a full enabling disclosure that applies to printed publications.<sup>1</sup>

Literally, Section 102(a) differentiates between “patented” and “described.” Thus, it could be argued that a prior patent which actually claimed certain subject matter would anticipate as to that subject matter even though it did not contain a supporting disclosure in such detail as to teach a person with ordinary skill in the art how to make and use the subject matter.

However, in *United States v. Adams* (1966),<sup>2</sup> the Supreme Court implicitly rejected this interpretation of “patented.” The Court dismissed reliance on a prior 1880 British patent to Skrivanoff. An expert attempted to make the product in accordance with Skrivanoff’s teachings “but was met first with a fire . . . and then with an explosion.” The Court held that such an inoperable invention could not negative novelty: “That in 1880 Skrivanoff may have been able to convince a foreign patent examiner to issue a patent on his device has little significance in the light of the foregoing.”<sup>3</sup>

In *In re Benno* (1985),<sup>4</sup> the Federal Circuit held that it was error for the Patent and Trademark Office to reject a claim in a patent application merely because the subject matter of that claim fell within the broadly-worded claim of a prior art patent.

“The scope of a patent’s claims determines what infringes the

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§ 3.06[1]

<sup>1</sup> *E.g.*, *In re Moreton*, 288 F.2d 708, 711, 129 U.S.P.Q. 227 (C.C.P.A. 1961), discussed § 3.06[1][b] *infra*. See also *Safetran Sys. Corp. v. Federal Sign & Signal Corp.*, 215 U.S.P.Q. 979 (N.D. Ill. 1981); *Electro-Nucleonics Laboratories, Inc. v. Abbott Laboratories*, 214 U.S.P.Q. 139 (N.D. Ill. 1981); *Kistler Instrumente AG v. United States*, 203 U.S.P.Q. 511 (Ct. Cl. Trial Div. 1979) *aff’d* 628 F.2d 1303 (Ct. Cl. 1980).

<sup>2</sup> 383 U.S. 39, 15 L. Ed.2d 572, 86 S. Ct. 708, 148 U.S.P.Q. 479 (1966), discussed at § 5.02[5][d] *infra*.

<sup>3</sup> 383 U.S. at 50. See also *Wycoff v. Motorola, Inc.*, 502 F. Supp. 77, 92, 209 U.S.P.Q. 115 (N.D. Ill. 1980); *Molinaro v. Burnbaum*, 201 U.S.P.Q. 83 (D. Mass. 1977).

<sup>4</sup> 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985). See also *Corning Glass Works v. Sumitomo Electric USA Inc.*, 5 U.S.P.Q.2d 1545, 1563 (S.D. N.Y. 1987), *aff’d*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) (“A prior art patent (or published application) is a reference only for that which it teaches.”).

patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding. While it is true . . . that 'a claim is part of the disclosure,' that point is of significance principally in the situation where a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification (claims being technically part of the 'specification,' 35 USC 112, 2d par.), in which case the applicant may amend the specification without being charged with adding 'new matter,' within the meaning of § 132. . . . But that is not the situation here. [The claim of the prior art patent] does not disclose any structure additional to what the . . . specification discloses."<sup>5</sup>

[b]—Foreign Patents. Some decisions suggest that a higher standard of adequate disclosure applies to foreign patents.<sup>6</sup> However, the statute (Section 102(a)) makes no distinction between foreign and domestic patents. Hence, as in the case of foreign publications,<sup>7</sup> the better view is that the same standard of disclosure applies to foreign and domestic patents. In *In re Moreton* (1961),<sup>8</sup> the Court of Cus-

<sup>5</sup> 768 F.2d 1346, 226 U.S.P.Q. at 686-687.

<sup>6</sup> *Aluminum Co. of Am. v. Sperry Prods., Inc.*, 285 F.2d 911, 922, 127 U.S.P.Q. 394 (6th Cir. 1960); *Borg-Warner Corp. v. Mall Tool Co.*, 220 F.2d 803, 805, 105 U.S.P.Q. 147 (7th Cir. 1955); *Carson v. American Smelting & Ref. Co.*, 4 F.2d 463, 465 (9th Cir. 1925) ("A foreign patent is to be measured as anticipatory, not by what might have been made out of it, but by what is clearly and definitely expressed in it. An American patent is not anticipated by a prior foreign patent, unless the latter exhibits the invention in such full, clear, and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments."); *Phillips Elec. & Pharmaceutical Indus., Inc.*, 311 F. Supp. 17, 28, 165 U.S.P.Q. 185 (D.N.J. 1970) *aff'd* 450 F.2d 1164, 171 U.S.P.Q. 641 (3d Cir. 1971); *Howe v. General Motors Corp.*, 252 F. Supp. 924, 928, 149 U.S.P.Q. 808 (N.D. Ill. 1966). See generally Note, "Prior Art in Patent Law," 73 Harv. L. Rev. 369, 377 (1959).

<sup>7</sup> See § 3.04[1][d] *supra*.

<sup>8</sup> 288 F.2d 708, 711, 129 U.S.P.Q. 227 (C.C.P.A. 1961). See also *Steelcase, Inc. v. Delwood Furniture Co.*, 578 F.2d 74, 199 U.S.P.Q. 69 (5th Cir. 1978) ("The state of the art does not depend on the provincial view that the available knowledge is only that published in one locality or contained only in domestic patents."); *In re Baum*, 374 F.2d 1004, 153 U.S.P.Q. 190 (C.C.P.A. 1967); *Monroe Auto Equip. Co. v. Heckethorn Mfg.*, 332 F.2d 406, 413, 141 U.S.P.Q. 549 (6th Cir. 1964); *In re Krammes*, 314 F.2d 813, 817, 137 U.S.P.Q. 60 (C.C.P.A. 1963); *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 990, 52 U.S.P.Q. 138 (2d Cir. 1942); *Barr*